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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,200	03/24/2006	Shinya Tokumaru	Q93850	3310
23373	7590	05/12/2009	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			GREENE, JASON M	
ART UNIT	PAPER NUMBER			
		1797		
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05/12/2009	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,200	<b>Applicant(s)</b> TOKUMARU, SHINYA
	<b>Examiner</b> Jason M. Greene	<b>Art Unit</b> 1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 January 2009.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3-6 and 8-11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 1,3-6,8,10 and 11 is/are allowed.

6) Claim(s) 9 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 24 March 2006 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- 1) Certified copies of the priority documents have been received.
- 2) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- 3) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

***Response to Arguments***

1. Applicant's arguments, see page 6, line 12, to page 16, line 1, filed 30 January 2009, with respect to the 35 USC 102 and 103 rejections of claims 1, 2-6 and 8 have been fully considered and are persuasive. The 35 USC 102 and 103 rejections of claims 1, 2-6 and 8 have been withdrawn.

2. Applicants' arguments, see page 12, lines 1-19, filed 30 January 2009, with respect to the 35 USC 102 and 103 rejections of claim 9 as being anticipated by Wood or obvious over JP '731 in view of Kotani et al. have been fully considered and are persuasive. The 35 USC 102 and 103 rejections of claim 9 as being anticipated by Wood or obvious over JP '731 in view of Kotani et al. have been withdrawn.

3. Applicant's arguments filed 30 January 2009 with respect to the 35 USC 102 rejection of claim 9 as being anticipated by Kotani et al. have been fully considered but they are not persuasive.

The Examiner agrees with Applicants that Kotani et al. teaches an outer coating on a honeycomb body. However, claim 9 is directed to a material that has an intended

use as a plugging material. While Kotani et al. does not teach the plugged honeycomb filter of claim 1, it still anticipates claim 9 since the material taught by Kotani et al. is fully capable of serving as a plugging material.

Furthermore, Applicants' arguments directed to the fact that Kotani mentions the possibility of replacing at least some of the cordierite particles with ceramic fibers is not persuasive. Specifically, Kotani et al. states that the cordierite particles **may** by at least partially replaced with ceramic fibers. Thus, while the possibility of replacing some of the cordierite particles is envisioned by the reference, it is by no means a requirement. The fact that **may** is used clearly conveys that the reference encompasses embodiments wherein none of the cordierite is replaced. Therefore, the reference clearly anticipates the claimed material.

***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Kotani et al. (US 5,629,067).

Kotani et al. teaches a material that is capable of being used as a plugging material comprising cordierite particles colloidal oxide (colloidal silica or colloidal alumina) in Figs. 1-5 and col. 4, line 66 to col. 14, line 67.

With regard to the material being a plugging material, intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re Finsterwalder*, 168 USPQ 530 (CCPA 1971). Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666 (PTO Board of Appeals 1969). Inclusion of the material worked upon by a structure being claimed does not impart patentability to the claims, *In re Otto et al.*, 136 USPQ 458 (CCPA 1963). A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of that claimed, *Ex parte Masham*, 2 USPQ 2d 1647 (PTO Board of Appeals 1987).

***Allowable Subject Matter***

6. Claims 1, 3-6, 8, 10 and 11 are allowed.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Greene whose telephone number is (571) 272-1157. The examiner can normally be reached on Monday - Friday (9:00 AM to 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason M. Greene  
Primary Examiner  
Art Unit 1797

/Jason M. Greene/  
5/10/09

jmg  
May 10, 2009